

Remarks

1. Summary of the office action

In the office action mailed March 30, 2010, (i) the Examiner rejected claims 1, 5-11, 13-18, 20, 22, 24, 26, 27, 29, and 30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0037068 (Thomas), and (ii) the Examiner rejected claims 2, 23, 25, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Official Notice.

2. Claim amendments and status of the claims

Applicant has cancelled claims 16 and 20. Claims 1, 2, 5-11, 13-15, 17, 18, and 22-30 are pending. Of the pending claims, claims 1 and 29 are independent.

3. Priority document

The Examiner noted that Thomas claims domestic priority, under 35 U.S.C. § 119(e), to Provisional Application No. 60/193,894 (hereinafter Thomas-Provisional), filed on March 31, 2000. The current application (i.e., U.S. Patent Application No. 09/978,170) claims priority to U.S. Patent Application Nos. 60/240,714 and 60/240,715. U.S. Patent Application Nos. 60/240,714 and 60/240,715 were filed on October 15, 2000, which is after the March 31, 2000 filing date of Thomas-Provisional but prior to the March 30, 2001 filing date of Thomas.

Thomas includes subject matter that was not disclosed in Thomas-Provisional. Applicant submits that the subject matter of Thomas that was not disclosed in Thomas-Provisional is not prior art to U.S. Patent Application Nos. 60/240,714 and 60/240,715 or to the claims of the current application that are supported by U.S. Patent Application Nos. 60/240,714 and/or 60/240,715.

Support for independent claim 1 is located in U.S. Patent Application No. 60/240,714, for example, at (i) page 5, last paragraph, lines 1-3, (ii) page 6, first paragraph, lines 1-4, (iii) page 7, lines 4-5, (iv) page 8, last paragraph, lines 2 and 6-10, (v) page 9, lines 3-4 and 17-18, (vi) page 10, lines 18-19, (vii) page 23, (viii) page 24, last paragraph, lines 1-3, and (ix) Figure 1(a). Since claim 1 is supported by U.S. Patent Application Nos. 60/240,714 and since Thomas is not prior art to U.S. Patent Application Nos. 60/240,714, Applicant submits that Thomas is not prior art to claim 1.

Support for independent claim 29 is located in U.S. Patent Application No. 60/240,714, for example, at (i) page 5, last paragraph, lines 1-3, (ii) page 6, first paragraph, lines 1-4, (iii) page 7, lines 4-5 and 23-24, (iv) page 8, last paragraph, lines 2 and 6-10, (v) page 9, lines 3-4 and 17-18, (vi) page 10, lines 18-19, (vii) page 23, (viii) page 24, last paragraph, lines 1-3, and (ix) Figure 1(a). Since claim 29 is supported by U.S. Patent Application Nos. 60/240,714 and since Thomas is not prior art to U.S. Patent Application Nos. 60/240,714, Applicant submits that Thomas is not prior art to claim 29.

4. Response to the rejections

a. Response to rejections of claims 1, 2, 5-11, 13-15, 17, 18, and 22-30

The Examiner rejected independent claims 1 and 29 under 35 U.S.C. § 102(e) as being anticipated by Thomas. As stated above, Thomas is not prior art to claims 1 and 29. Therefore, Applicant addresses the rejections of claims 1 and 29 with respect to Thomas-Provisional instead of Thomas.

According to M.P.E.P. § 2131, in order for a reference to anticipate a claim, the reference must teach each and every element as recited in the claim. Thomas-Provisional clearly does not teach each and every element as recited in claim 1. At a minimum, Thomas-Provisional does not

teach or suggest “upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused; and after the time delay has elapsed, displaying the ad on the display of the video replay system instead of the user selected program content,” as recited in claim 1.

Thomas-Provisional discloses, “In conventional systems, pausing a real-time or *recorded program* causes the system to “freeze” the current picture.” See, Thomas-Provisional, page 2 lines 3-5, emphasis added. Thomas-Provisional does not teach or suggest that the conventional systems display, after a time delay has elapsed, an ad on the display instead of the real-time or recorded program.

In addition to the conventional systems, Thomas-Provisional discloses an alternative arrangement, i.e., a media recording system of its invention. In particular, Thomas-Provisional discloses, “When a user pauses a real-time or *recorded program*, the media recording system presents pause-time content *instead of* a paused picture of the last frame,” and “the pause-time content may be, for example, advertisements” See, Thomas-Provisional, page 2 lines 18-20 and 27-28, emphasis added. Although Thomas-Provisional discloses that the alternative arrangement (i.e., the media recording system) can present an advertisement when a user pauses a recorded program, Thomas-Provisional does not teach or suggest that the media recording system displays the recorded program during a pause mode. Indeed, Thomas-Provisional discloses that the media recording system presents the advertisement *instead of* presenting a paused picture of the last frame.

Since the conventional systems of Thomas-Provisional do not display an ad and since the alternative arrangement (i.e., the media recording system) of Thomas-Provisional does not

display paused program content during the pause mode, Applicant submits that Thomas-Provisional does not disclose or suggest (i) upon entering the pause mode, during a time delay greater than zero seconds, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, and (ii) after the time delay has elapsed, displaying the ad on the display of the video replay system instead of the user selected program content, as recited in claim 1.

Since Thomas is not prior art to claim 1 and since Thomas-Provisional does not teach or suggest every element as recited in claim 1, Applicant submits that neither Thomas nor Thomas-Provisional anticipate claim 1. Accordingly, Applicant submits that claim 1 is allowable. Furthermore, claims 2, 5-11, 13-15, 17, 18, 22-28, and 30 should be allowed as well for at least the reason that they depend from allowable claim 1.

Applicant submits that the Examiner erred in rejecting claim 29 in largely the same way that the Examiner erred in rejecting claim 1. Therefore, Applicant submits that claim 29 is allowable.

Furthermore, claim 1 recites "entering a pause mode in response to a user action that comprises pressing a pause key." Although Thomas-Provisional discloses a user pausing a real-time or recorded program, Thomas-Provisional does not disclose or suggest a pause key. Accordingly, Applicant further submits that Thomas-Provisional does anticipate claim 1 because Thomas-Provisional does not teach or suggest entering a pause mode in response to a user action that comprises pressing a pause key.

b. Response to the rejection of claim 2

Claim 2 is allowable for the reason stated above.

Furthermore, in rejecting claim 2, the Examiner took Official Notice “that it is common practice in the art that a user sets a time delay after which a system enters a pause mode and presents thereon a pause-timing content.” *See*, office action, page 10, last paragraph. Applicant respectfully submits that the Examiner erred in taking Official Notice for claim 2 because it was not common practice for a system to enter a pause mode after expiration of a time delay, and hence it was not common practice for a user to set a time delay after which a system enters a pause mode and presents thereon a pause-timing content. Applicant respectfully requests that the Examiner produce authority that it was common practice in the art for a user to set a time delay after which a system enters a pause mode and presents thereon a pause-timing content.

Furthermore, Applicant points out that the time delay of the Official Notice taken for claim 2 is executed prior to entering a pause mode. This differs from the time delay of claim 1 which is executed upon entering the pause mode. Thus, even if it was common practice for a user to set a time delay that is executed prior to entering a pause mode, Applicant submits that such practice does not amount to common practice for a user to set a time delay that is executed upon entering a pause mode.

c. Response to the rejections of claims 16 and 20

The Examiner rejected claims 16 and 20 under 35 U.S.C. § 102(e) as being anticipated by Thomas. Applicant has cancelled claims 16 and 20. Applicant submits that the rejections of claims 16 and 20 are now moot. Applicant respectfully requests that the Examiner withdraw the rejections of claims 16 and 20 under 35 U.S.C. § 102(e). Applicant does not give up the right to pursue the subject matter of claims 16 and 20 in a continuing application.

5. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. For the foregoing reasons, Applicant submits that claims 1-2, 5-11, 13-15, 17, 18, and 22-30 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the pending claims.

Respectfully submitted,

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